

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Group Art Unit 3722

In re

Patent Application of

Eric E. Blohm et al.

Application No. 10/607,233

Confirmation No. 5865

Filed: June 26, 2003

Examiner: Pradeep Choudary Battula

"PRINTED PRODUCT BINDING METHOD"

**APPEAL BRIEF**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This communication is filed in response to the Office action dated May 12, 2008 and further to the Notice of Appeal filed August 12, 2008. This Brief is the second Appeal Brief (the first being filed on February 26, 2008 in response to the final Office action dated July 31, 2007).

The fee required by 37 CFR 41.20(b)(2) was paid with the first Appeal Brief, and as such, no fee is currently due (MPEP 1207.04). Please charge any additional fees or credit any overpayment to Deposit Account No. 13-3080.

(i) *Real party in interest*

The real party in interest is Quad/Graphics, Inc., N63w23075 Highway 74, Sussex, WI 53089 as recorded by the assignment at reel/frame 014243/0776.

(ii) *Related appeals and interferences*

There are no related appeals or interferences.

(iii) *Status of claims*

Claims 1-26 and 28-31 are currently pending in the application. Claim 27 is canceled. Of the pending claims, no claims are allowed, no claims are objected to, and Claims 1-26 and 28-31 are rejected. Claims 1-26 and 28-31 are presently being appealed.

(iv) *Status of amendments*

No amendments have been filed subsequent to final rejection.

(v) *Summary of claimed subject matter*

Independent claim 1 defines a binding method comprising generating a pre-personalized book on a binding line for a specific individual, rejecting selective pre-personalized books, and generating an alternate piece, of an alternate medium compared to the pre-personalized book, in place of each rejected pre-personalized book to be delivered to the specific individual (*page 2, lines 6-9; page 3, lines 29-31; page 5, lines 10-20; page 6, lines 7-9; page 6, lines 30-34; page 7, lines 21-25; Figs. 1-6*).

Independent claim 9 defines a binding method comprising generating a mailing list of recipients, generating a pre-personalized book for each recipient on a binding line, rejecting one of the pre-personalized books, identifying the recipient of the rejected pre-personalized book, and generating an alternate piece that replaces the rejected pre-personalized book (*page 2, lines 10-14; page 4, lines 26-29; page 5, lines 10-11; page 5, line 24-page 6, line 16; page 6, lines 30-34; Figs. 1-5*). The alternate piece includes a notification to the recipient regarding the status of their pre-personalized book (*page 6, lines 11-14*).

Independent claim 15 defines a method of replacing a rejected book on a binding line. The method comprises generating a mailing list of recipients having a mailing order, assembling a pre-personalized book on the binding line for each recipient according to the mailing list, rejecting selective pre-personalized books, generating an alternate piece on the binding line, the alternate piece being of a format different from the rejected pre-personalized book, and replacing the rejected pre-personalized book with the alternate piece (*page 5, lines 10-20; Figs. 1-3*). The alternate piece is positioned on the binding line to maintain the mailing order (*page 2, lines 15-20; page 5, line 33-page 6, line 5; page 6, lines 32-34; Figs. 4 and 5*).

Independent claim 21 defines a binding method comprising generating a mailing list of recipients, generating a pre-personalized printed product off-line for selected recipients on the mailing list, loading the pre-personalized printed products adjacent a binding line, assembling a book for each recipient including a respective pre-personalized printed product, rejecting selective recipients' books, removing the rejected books from the binding line, and generating an alternate piece in place of each rejected book, the alternate piece being of a different medium than the pre-personalized printed product (*page 2, lines 21-26; page 5, lines 10-20; page 6, lines 7-9; page 7, lines 3-25; Figs. 1-3, 6*).

Independent claim 24 defines a binding method comprising generating a pre-personalized book on a binding line for a plurality of specific individuals, each pre-personalized book having therein a pre-personalized signature, rejecting selective pre-personalized books, reprinting the pre-personalized signature of one of the rejected pre-personalized books, and regenerating the rejected pre-personalized book on the binding line for the specific individual to include the reprinted pre-personalized signature (*page 2, line 27-page 3, line 4; page 4, line 26-page 5, line 6; page 7, lines 3-25; Figs. 1-3, 6*).

Independent claim 28 defines a binding method comprising generating a mailing list of recipients, generating a pre-personalized printed product for each recipient, assembling a book on a binding line for each recipient, each said book including the respective pre-personalized piece, rejecting selective books, removing the rejected books from respective spaces along the binding line, generating an alternate pre-personalized piece for each recipient whose book was rejected, the alternate pre-personalized piece being of a different medium than the pre-personalized printed product, and inserting the alternate pre-personalized piece into the space previously occupied by the respective rejected book (*page 5, lines 10-20; Figs. 1-3; page 5, line 33-page 6, line 9; page 6, lines 22-34; Figs. 4 and 5*).

Independent claim 31 defines a method of replacing a rejected book on a binding line. The method comprises generating a mailing list of recipients, assembling a pre-personalized book on the binding line for each recipient, rejecting selected pre-personalized books, replacing a first rejected book with a generic book, replacing a second rejected book with a regenerated second book identical to what the second rejected book should have been, and replacing a third rejected book with a different medium (*page 4, line 26-page 5, line 20; page 6, lines 7-9; Figs. 1-3*).

(vi) *Grounds of rejection to be reviewed on appeal*

Applicants appeal the rejection made in the Office action dated May 12, 2008, and request that the Board review whether claims 1, 3, 4, 6, 9, 10, 11, 13, 21-23, 28 and 30 are anticipated under 35 U.S.C. §102(b) by United States Patent No. 6,347,260 ("Graushar").

Applicants appeal the rejection made in the Office action dated May 12, 2008, and request that the Board review whether claims 24-26 are anticipated under 35 U.S.C. §102(b) by United States Patent No. 3,819,173 ("Anderson").

Applicants appeal the rejection made in the Office action dated May 12, 2008, and request that the Board review whether claims 15-20, and 31 are anticipated under 35 U.S.C. §102(e) by U.S. Patent No. 6,694,219 ("Graushar '219").

Applicants appeal the rejection made in the Office action dated May 12, 2008, and request that the Board review whether claims 2, 5, 7, 8, 12, 14, and 29 are unpatentable under 35 U.S.C. §103(a) over Graushar in view of Graushar '219.



(vii) *Argument*

**Claim Rejections under 35 U.S.C. §102(b) – Graushar**

The Examiner rejects claims 1, 3, 4, 6, 9, 10, 11, 13, 21-23, 28, and 30 under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 6,347,260 ("Graushar").

**Claims 1, 3, 4, and 6**

Claim 1 defines a binding method comprising:

generating a pre-personalized book on a binding line for a specific individual,  
rejecting selective pre-personalized books, and  
generating an alternate piece, of an alternate medium compared to the pre-personalized book, in place of each rejected pre-personalized book to be delivered to the specific individual.

Graushar fails to disclose, teach or suggest generating an alternate piece, of an alternate medium compared to the pre-personalized book, in place of each rejected pre-personalized book to be delivered to the specific individual. Accordingly, Claim 1 is not anticipated by Graushar.

Graushar discloses a multi-mailer, which combines pre-personalized printed items and items that are not pre-personalized in zip code order. Unacceptable books are rejected and replaced by generic books (column 2, line 66 to column 3, line 4). Personalization on inside pages of select books occurs after the inspection.

Rather than generating an alternate piece, **of an alternate medium compared to the pre-personalized book**, in place of each rejected pre-personalized book to be delivered to the specific individual, Graushar discloses only rejecting a book and replacing it with another book (i.e., the very same medium). MPEP 2111 and 2111.01 provide guidance on claim language interpretation. Applicants appreciate the Office's need to broadly interpret claim language, but insist that the interpretation given by the Examiner to "alternate medium" in order to justify the rejection goes beyond the broadest **reasonable** interpretation based on the plain meaning of the term as it would be understood by one of ordinary skill in the art.

Applicants have made no attempt to give the phrase “alternate medium” an unconventional meaning for the purpose of this patent application. Rather, Applicants have provided examples in the specification consistent with the conventional meaning of what alternate forms of media actually are. Absent an express intent to broaden the meaning of the claim language, the Office is obliged to consider the language with the broadest **reasonable interpretation, consistent with the specification**. Applicants submit that the Examiner has extended the interpretation of the claim language beyond what is reasonable based on the plain meaning and based on Applicants’ specification.

Therefore, Graushar fails to disclose, teach or suggest generating an alternate piece, **of an alternate medium compared to the pre-personalized book**, in place of each rejected pre-personalized book to be delivered to the specific individual, as claimed.

Claim 1 is allowable for this and other reasons. Claims 3, 4, and 6 depend from Claim 1 and are allowable for at least the same reasons.

Claims 9, 10, 11, and 13

Claim 9 defines a binding method comprising:

- generating a mailing list of recipients,
- generating a pre-personalized book for each recipient on a binding line,
- rejecting one of the pre-personalized books,
- identifying the recipient of the rejected pre-personalized book, and
- generating an alternate piece that replaces the rejected pre-personalized book, wherein the alternate piece includes a notification to the recipient regarding the status of their pre-personalized book.

Graushar fails to disclose, teach or suggest replacing a rejected book with an alternate piece that includes a notification to the recipient. Accordingly, Claim 9 is not anticipated by Graushar.

The disclosure of Graushar is related to replacing a pre-personalized book with a generic book. The Examiner states on pages 3-4 of the May 12, 2008 Office action that an alternate piece (generic book) of Graushar notifies the recipient of the status simply by the fact that the book is generic. The Examiner is correct that the knowledge of the recipient is largely

irrelevant, but Graushar must provide adequate disclosure to support a rejection under 35 U.S.C. §102(b). Applicants submit that this is another instance of the Examiner giving the claim language an unreasonably broad interpretation that is inconsistent with the specification.

Applicants' claim positively recites **"generating an alternate piece...wherein the alternate piece includes a notification to the recipient regarding the status of their pre-personalized book."** The claim is very clear that a notification is included, as supported in the specification (*page 6, lines 11-14*). Therefore, to say that the mere delivery of a generic book is the same as the step of Applicants' method discussed above is a misinterpretation of 35 U.S.C. §102(b) if the claim language is given its proper, plain meaning (MPEP 2111.01). Applicants have made no express attempt to broaden or change the meaning of the phrases included in the claim. Thus, the Examiner's interpretation is unjustifiably broad in order to construe Graushar's generic book as anticipating Applicants' claim. The fact that a recipient of Graushar's generic book can be aware of the intended book (*page 4, Office action dated May 12, 2008*) is not an actual teaching of Applicants' claimed method step by the Graushar reference. It is also not **inherent** or **necessarily** the case that a recipient is aware of the intended book.

Therefore, Graushar fails to disclose, teach or suggest generating an alternate piece that replaces the rejected pre-personalized book, wherein the alternate piece includes a notification to the recipient regarding the status of their pre-personalized book, as claimed.

Claim 9 is allowable for this and other reasons. Claims 10, 11, and 13 depend from Claim 9 and are allowable for at least the same reasons.

#### Claims 21-23

Claim 21 defines a binding method comprising:

- generating a mailing list of recipients,
- generating a pre-personalized printed product off-line for selected recipients on the mailing list,
- loading the pre-personalized printed products adjacent a binding line,
- assembling a book for each recipient including a respective pre-personalized printed product,

rejecting selective recipients' books,  
removing the rejected books from the binding line, and  
generating an alternate piece in place of each rejected book, the alternate piece  
being of a different medium than the pre-personalized printed product.

Graushar discloses a multi-mailer, which combines pre-personalized printed items and items that are not pre-personalized in zip code order. Unacceptable books are rejected and replaced by generic books (column 2, line 66 to column 3, line 4). Personalization on inside pages of select books occurs after the inspection.

Graushar fails to disclose, teach, or suggest at least the following limitation of Claim 21:

**generating an alternate piece in place of each rejected book, the alternate piece  
being of a different medium than the pre-personalized printed product.**

As defined by Applicants' Claim 21, the alternate piece must be a different medium than the pre-personalized printed product. As one example of this concept, if the pre-personalized printed product was a magazine page, the alternate piece must be a medium other than a magazine page. The alternate piece could be a different type of printed media or any type of electronic media. As defined in Applicants' specification, the alternate piece may take one of many media forms, some of which are printed and some of which are electronic. See e.g., Applicants' specification at least at page 5, lines 17-20 and at page 6, lines 7-9. Conversely, Graushar discloses rejecting a book and replacing it with another book. Thus, the type of communicative medium (i.e., signatures and inserts that constitute a book) of the replacement is exactly the same as the rejected book and is not **"of a different medium,"** although the information contained in the generic book of Graushar may be different from the rejected book.

As stated above, Applicants insist that the interpretation given by the Examiner to "of a different medium" in order to justify the rejection goes beyond the broadest **reasonable** interpretation based on the plain meaning of the phrase as it would be understood by one of ordinary skill in the art.

Applicants have made no attempt to give the phrase an unconventional meaning for the purpose of this patent application. Rather, Applicants have provided examples in the specification consistent with the conventional meaning of what alternate forms of media actually are. Absent an express intent to broaden the meaning of the claim language, the Office is

obliged to consider the language with the broadest **reasonable** interpretation, **consistent with the specification**. Applicants submit that the Examiner has extended the interpretation of the claim language beyond what is reasonable based on the plain meaning and based on Applicants' specification.

Therefore, Graushar does not disclose, teach or suggest assembling a book for each recipient comprising a respective pre-personalized printed product and generating an alternate piece in place of each rejected book, the alternate piece being of a different medium than the pre-personalized printed product, as claimed.

Claim 21 is allowable for this and other reasons. Claims 22 and 23 depend from claim 21 and are allowable for at least the same reasons.

#### Claims 28 and 30

Claim 28 defines a binding method comprising:

generating a mailing list of recipients,  
generating a pre-personalized printed product for each recipient,  
assembling a book on a binding line for each recipient, each said book including the respective pre-personalized piece,  
rejecting selective books,  
removing the rejected books from respective spaces along the binding line,  
generating an alternate pre-personalized piece for each recipient whose book was rejected, the alternate pre-personalized piece being of a different medium than the pre-personalized printed product, and  
inserting the alternate pre-personalized piece into the space previously occupied by the respective rejected book.

Graushar fails to disclose, teach, or suggest at least the following limitations of Claim 28:

- 1) **generating an alternate pre-personalized piece for each recipient whose book was rejected,**
- 2) **the alternate pre-personalized piece being of a different medium than the pre-personalized printed product, and**

**3) inserting the alternate pre-personalized piece into the space previously occupied by the respective rejected book.**

Graushar fails to disclose generating an alternate pre-personalized piece for each recipient whose book was rejected. Instead, Graushar discloses generating an alternate piece that is generic, not pre-personalized.

Graushar further fails to disclose that the alternate pre-personalized piece is of a different medium than the pre-personalized printed product that was rejected. Instead, Graushar discloses rejecting a book and replacing it with another book (i.e., **the very same medium**), albeit generic. Even though the original book is pre-personalized and the replacement book is generic, both are provided as identical forms of printed media.

Lastly, Graushar fails to disclose inserting the alternate pre-personalized piece into the space previously occupied by the respective rejected book because, again, Graushar fails to disclose even the step of generating an alternate pre-personalized piece for each recipient whose book was rejected.

As stated above, the Office is obliged to give the phrase "of a different medium" a **reasonably** broad definition that is **consistent with the specification**. Applicants submit that the Examiner's interpretation of the claim language is not consistent with the specification, but rather is unreasonably broad in order to maintain a rejection in view of Graushar.

Therefore, Graushar fails to disclose, teach or suggest generating an alternate pre-personalized piece for each recipient whose book was rejected, the alternate pre-personalized piece being of a different medium than the pre-personalized printed product, and inserting the alternate pre-personalized piece into the space previously occupied by the respective rejected book, as claimed.

Claim 28 is allowable for this and other reasons. Claim 30 depends from Claim 28 and is allowable for at least the same reasons.

**Claim Rejections under 35 U.S.C. §102(b) – Anderson**

The Examiner rejects claims 24-26 under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 3,819,173 ("Anderson").

## Claims 24-26

Claim 24 defines a binding method comprising:

generating a pre-personalized book on a binding line for a plurality of specific individuals, each pre-personalized book having therein a pre-personalized signature,

rejecting selective pre-personalized books,

reprinting the pre-personalized signature of one of the rejected pre-personalized books, and

regenerating the rejected pre-personalized book on the binding line for the specific individual to include the reprinted pre-personalized signature.

Anderson discloses printing and/or punching a new renewal card for insertion into the replacement magazine. Column 1, paragraph 3 of Anderson suggests that a particular magazine title may include different advertising (e.g., different signatures) for different subscriber groups.

Anderson, however, fails to disclose at least the following limitations of Claim 24:

- 1) **reprinting the pre-personalized signature of one of the rejected pre-personalized books , and**
- 2) **regenerating the rejected pre-personalized book on the binding line for the specific individual to include the reprinted pre-personalized signature.**

Anderson fails to disclose reprinting the pre-personalized signature of one of the rejected pre-personalized books. Instead, Anderson discloses that magazines, whether new or reordered, are assembled from signatures already in the inserter (10). Thus, the signatures are **not reprinted** for a particular subscriber's magazine, nor are the signatures pre-personalized. The Examiner correctly identifies that, when a magazine is re-ordered, signatures are again fed from the feeders. Applicants submit that the **feeding** of a signature from a feeder is not sufficient to anticipate the claimed step of **reprinting** a pre-personalized signature. Although Anderson discloses reprinting and punching a renewal card, the claim refers specifically to a signature being reprinted. The renewal card of Anderson is not a signature as characterized by Applicants' specification, Anderson's specification, or as understood by one of ordinary skill in

the art. Applicants' specification even differentiates between signatures and inserts on page 3, lines 29-31. Thus, to consider the renewal card of Anderson to satisfy Applicants' claim requirements when the claim recites a signature would be improper as it is inconsistent with Applicants' specification, which makes no attempt to broaden the terminology beyond the plain meaning as recognized by one of ordinary skill in the art.

Further, Anderson fails to disclose regenerating the rejected pre-personalized book on the binding line for the specific individual to include the reprinted pre-personalized signature, in part, because as stated above Anderson fails to disclose reprinting the pre-personalized signatures and, therefore, cannot regenerate the rejected pre-personalized book, as claimed.

Therefore, Anderson fails to disclose, teach or suggest reprinting the pre-personalized signature of one of the rejected pre-personalized books and regenerating the rejected pre-personalized book on the binding line for the specific individual to include the reprinted pre-personalized signature, as claimed.

Claim 24 is allowable for this and other reasons. Claims 25 and 26 depend from Claim 24 and are allowable for at least the same reasons.

#### **Claim Rejections under 35 U.S.C. §102(e) – Graushar '219**

The Examiner rejects claims 15-20, and 31 as being anticipated under 35 U.S.C. §102(e) by U.S. Patent No. 6,694,219 ("Graushar '219")

#### **Claims 15-20**

Claim 15 defines a method of replacing a rejected book on a binding line. The method comprises:

- generating a mailing list of recipients having a mailing order,
- assembling a pre-personalized book on the binding line for each recipient according to the mailing list,
- rejecting selective pre-personalized books,
- generating an alternate piece on the binding line, the alternate piece being of a format different from the rejected pre-personalized book, and



replacing the rejected pre-personalized book with the alternate piece, the alternate piece positioned on the binding line to maintain the mailing order.

Graushar '219 does not disclose, teach or suggest generating an alternate piece on the binding line, the alternate piece being of a different format from a rejected pre-personalized book. Accordingly, Graushar '219 does not anticipate the subject matter of independent claim 15 under 35 U.S.C. §102(e).

Graushar '219 discloses a method and apparatus for assembling a magazine with a CD or a DVD. The Examiner has pointed to portions of the disclosure of Graushar '219 that state that a rejected magazine may be replaced by another magazine that is either standard, customized, personalized, or customized/personalized.

Applicants submit that Graushar '219 does not disclose an alternate piece of a different format from the rejected book, because both are magazines. Applicants have initiated no reason for the claim language to assume any meaning other than its plain meaning. In accordance with the specification, two items of different format are not two magazines (regardless of differing shape, size, and/or content).

Therefore, Graushar '219 fails to teach or suggest generating an alternate piece on the binding line, the alternate piece being of a different format from a rejected pre-personalized book, as claimed.

Claim 15 is allowable for this and other reasons. Claims 16-20 depend from Claim 15 and are allowable for at least the same reasons.

#### Claim 31

Claim 31 defines a method of replacing a rejected book on a binding line, comprising:

generating a mailing list of recipients,  
assembling a pre-personalized book on the binding line for each recipient,  
rejecting selected pre-personalized books,  
replacing a first rejected book with a generic book,

replacing a second rejected book with a regenerated second book identical to what the second rejected book should have been, and  
replacing a third rejected book with a different medium.

Graushar '219 fails to disclose, teach or suggest replacing a rejected book with a different medium. Accordingly, the subject matter of independent claim 15 is not anticipated by Graushar '219 under 35 U.S.C. §102(e).

The disclosure of Graushar '219 contemplates replacing a rejected magazine with a replacement magazine that is standard, customized, personalized, or customized/personalized. The Examiner states that, because Applicants have not set forth a specific definition of what is meant by "different medium", that it has been broadly interpreted. However, the lack of a specific definition for a phrase in a claim does not give the Office cause for giving that phrase the broadest **possible** meaning, but rather, the broadest **reasonable** meaning, consistent with the specification. One of ordinary skill in the art would appreciate that the last stanza of this particular claim refers specifically to replacing a rejected book with something that is not a book. The Examiner's quotation to Applicants' specification on page 12 of the Office action dated May 12, 2008 gives several examples of replacement pieces that are not books. Thus, on the basis of Applicants' specification and the plain meaning of the phrase, there is no reason to interpret "different medium" as including differently-configured books (as taught by Graushar '219) in addition to items that are not books.

Therefore, Graushar '219 fails to teach or suggest replacing a first rejected book with a generic book, replacing a second rejected book with a regenerated second book identical to what the second rejected book should have been, and replacing a third rejected book with a different medium, as claimed.

Accordingly, Claim 31 is allowable for at least these reasons. Applicants respectfully request withdrawal of the rejection and allowance of Claim 31.

#### **Claim Rejections under 35 U.S.C. §103(a) – Graushar in view of Graushar '219**

The Examiner rejects claims 2, 5, 7, 8, 12, 14, and 29 as being unpatentable under 35 U.S.C. §103(a) over Graushar in view of Graushar '219

#### Claims 2, 5, 7, and 8

Claims 2, 5, 7, and 8 depend from Claim 1, which is discussed separately herein. Claim 2 is directed to the method of claim 1 wherein the pre-personalized book includes pre-personalized information and the alternate piece includes the same pre-personalized information. Claim 5 is directed to the method of claim 1 wherein the act of generating the alternate piece includes printing the alternate piece on the binding line. Claim 7 is directed to the method of claim 1 wherein the alternate piece is a printed product, particularly a post card. Claim 8 is directed to the method of claim 1 wherein the alternate piece is in electronic format. While Graushar '219 is generally relevant to magazines provided with electronic media, such as CDs or DVDs, it fails to cure the deficiencies of the base Graushar reference with respect to independent Claim 1.

Particularly, Graushar '219 does not disclose, teach, or suggest generating an alternate piece, of an alternate medium compared to a pre-personalized book, in place of each rejected pre-personalized book to be delivered to a specific individual.

Therefore, Applicants' respectfully request that the rejection to claims 2, 5, 7, and 8 be withdrawn and the claims allowed.

#### Claims 12 and 14

Claims 12 and 14 depend from Claim 9, which is discussed separately above. Claim 12 is directed to the method of claim 9 wherein the act of generating the alternate piece includes printing the alternate piece on the binding line. Claim 14 is directed to the method of claim 9 wherein the alternate piece is in electronic format. While Graushar '219 is generally relevant to magazines provided with electronic media, such as CDs or DVDs, it fails to cure the deficiencies of Graushar with respect to independent Claim 9.

Particularly, Graushar '219 does not disclose, teach, or suggest generating an alternate piece that replaces the rejected pre-personalized book, wherein the alternate piece includes a notification to the recipient regarding the status of their pre-personalized book, as claimed.

Therefore, Applicants' respectfully request that the rejection of claims 12 and 14 be withdrawn and the claims allowed.

Claim 29

Claim 29 depends from claim 28 and further recites that generating the alternate pre-personalized piece is done on the binding line. Claim 28 is allowable over Graushar for at least the reasons discussed in detail above. The disclosure of Graushar '219 fails to cure the deficiencies of Graushar with respect to independent Claim 28.

Particularly, Graushar '219 fails to disclose, teach, or suggest generating an alternate pre-personalized piece for each recipient whose book was rejected, the alternate pre-personalized piece being of a different medium than the pre-personalized printed product, and inserting the alternate pre-personalized piece into the space previously occupied by the respective rejected book.

Therefore, Applicants' respectfully request that the rejection of claim 29 be withdrawn and the claim allowed.

Respectfully submitted,



Jayson L. Hongsermeier  
Reg. No. 61,929

Docket No.: 077047-9497-00  
Michael Best & Friedrich LLP  
100 East Wisconsin Avenue  
Milwaukee, Wisconsin 53202-4108

(414) 271-6560

(viii) *Claims appendix*

1. A binding method comprising:  
generating a pre-personalized book on a binding line for a specific individual;  
rejecting selective pre-personalized books; and  
generating an alternate piece, of an alternate medium compared to the pre-personalized book, in place of each rejected pre-personalized book to be delivered to the specific individual.
2. The method of claim 1 wherein the pre-personalized book includes pre-personalized information and the alternate piece includes the same pre-personalized information.
3. The method of claim 1 wherein the pre-personalized book includes a pre-personalized signature.
4. The method of claim 1 wherein the act of generating the alternate piece includes printing the alternate piece off-line with respect to the binding line.
5. The method of claim 1 wherein the act of generating the alternate piece includes printing the alternate piece on the binding line.
6. The method of claim 1 wherein the alternate piece is a printed product.
7. The method of claim 6 wherein the alternate piece is a postcard.
8. The method of claim 1 wherein the alternate piece is in electronic format.

9. A binding method comprising:  
generating a mailing list of recipients;  
generating a pre-personalized book for each recipient on a binding line;  
rejecting one of the pre-personalized books;  
identifying the recipient of the rejected pre-personalized book; and  
generating an alternate piece that replaces the rejected pre-personalized book,  
wherein the alternate piece includes a notification to the recipient regarding the status of  
their pre-personalized book.
10. The method of claim 9 wherein the alternate piece is a printed product.
11. The method of claim 9 wherein the pre-personalized book includes pre-personalized information and the alternate piece includes the pre-personalized information.
12. The method of claim 9 wherein the act of generating the alternate piece includes printing the alternate piece on the binding line.
13. The method of claim 9 wherein the act of generating the alternate piece includes printing the alternate piece off-line with respect to the binding line.
14. The method of claim 9 wherein the alternate piece is in electronic format.

15. A method of replacing a rejected book on a binding line, the method comprising:  
generating a mailing list of recipients having a mailing order;  
assembling a pre-personalized book on the binding line for each recipient according to the mailing list;  
rejecting selective pre-personalized books;  
generating an alternate piece on the binding line, the alternate piece being of a format different from the rejected pre-personalized book; and  
replacing the rejected pre-personalized book with the alternate piece, the alternate piece positioned on the binding line to maintain the mailing order.
16. The method of claim 15 wherein the alternate piece is a postcard.
17. The method of claim 15 wherein the pre-personalized book includes pre-personalized information and the alternate piece includes the same pre-personalized information of the pre-personalized book.
18. The method of claim 15 wherein the pre-personalized book includes pre-personalized information and the alternate piece includes different pre-personalized information of the pre-personalized book.
19. The method of claim 15 wherein the alternate piece is a printed product.
20. The method of claim 15 wherein the alternate piece is in electronic format.

21. A binding method comprising:  
generating a mailing list of recipients;  
generating a pre-personalized printed product off-line for selected recipients on the mailing list;  
loading the pre-personalized printed products adjacent a binding line;  
assembling a book for each recipient including a respective pre-personalized printed product;  
rejecting selective recipients' books;  
removing the rejected books from the binding line; and  
generating an alternate piece in place of each rejected book, the alternate piece being of a different medium than the pre-personalized printed product.
22. The binding method of claim 21 wherein the alternate piece includes at least a portion of the pre-personalized information contained in the pre-personalized printed product for a given selected recipient.
23. The binding method of claim 21 and further including the act of generating a generic book to be sent to the selected recipients whose books, which were to include the pre-personalized printed products, were rejected.



24. A binding method comprising:  
generating a pre-personalized book on a binding line for a plurality of specific individuals, each pre-personalized book having therein a pre-personalized signature;  
rejecting selective pre-personalized books;  
reprinting the pre-personalized signature of one of the rejected pre-personalized books; and  
regenerating the rejected pre-personalized book on the binding line for the specific individual to include the reprinted pre-personalized signature.

25. The binding method of claim 24 wherein the step of reprinting the portion is done on the binding line.

26. The binding method of claim 24 wherein the step of reprinting the portion is done offline with respect to the binding line.

27. (Canceled)

28. A binding method comprising:  
generating a mailing list of recipients;  
generating a pre-personalized printed product for each recipient;  
assembling a book on a binding line for each recipient, each said book including the respective pre-personalized piece;  
rejecting selective books;  
removing the rejected books from respective spaces along the binding line;  
generating an alternate pre-personalized piece for each recipient whose book was rejected, the alternate pre-personalized piece being of a different medium than the pre-personalized printed product; and  
inserting the alternate pre-personalized piece into the space previously occupied by the respective rejected book.

29. The binding method of claim 28 wherein generating the alternate pre-personalized piece is done on the binding line.

30. The binding method of claim 28 wherein generating the alternate pre-personalized piece is done off line with respect to the binding line.

31. A method of replacing a rejected book on a binding line, the method comprising:
- generating a mailing list of recipients;
  - assembling a pre-personalized book on the binding line for each recipient;
  - rejecting selected pre-personalized books;
  - replacing a first rejected book with a generic book;
  - replacing a second rejected book with a regenerated second book identical to what the second rejected book should have been; and
  - replacing a third rejected book with a different medium.

(ix) *Evidence appendix*

None.

(x) *Related proceedings appendix*

None.